Docket No.: 9988.299.00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Chang Wook KIM	Customer No.: 30827
Application No.: 10/567,850	Confirmation No.: 7333
Filed: February 10, 2006	Art Unit: 3743
For: A DRUM OF LAUNDRY DRYER	Examiner: Stephen Michael Gravini

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Final Office Action mailed September 30, 2009, in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. Applicant respectfully submits that there are clear errors in the rejections and the Final Office Action has omitted one or more essential elements needed to establish a prima facie case of unpatentability.

1. **Wang Does Not Qualify as Prior Art**

In both the Non-Final and Final Office Action, claims 1-3, 5, 7, and 9-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,105,533 to Boos *et al.* (hereinafter "*Boos*") in view of U.S. Patent No. 2,932,091 to Day *et al.* (hereinafter "*Day*") and in view of U.S. Patent No. 7,194,824 to Wang *et al.* (hereinafter "*Wang*"). *Non-Final Office Action* at p. 3 & *Final Office Action* at p. 2. As discussed in the telephonic interview of October 27, 2009, and the Non-Final Office Action response of June 15, 2009, the rejection under 35 U.S.C § 103(a) is improper because *Wang* does not qualify as prior art under one or more subsections of 35 U.S.C. § 102.

It is well established law that any reference relied on in making a 35 U.S.C § 103(a) obviousness rejection must first qualify as prior art under one or more subsections of 35 U.S.C. § 102.

With respect to 35 U.S.C § 102(a), the Applicant shall be entitled to a patent unless "the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." *Wang* does not qualify as prior art under 102(a) because the Publication date of *Wang* is May 19, 2005. The present application claims the benefit of the filing date of the foreign application giving the present application an effective filing date of June 5, 2004 (the filing date of the Applicant's corresponding foreign application from which the instant application claims priority to) is prior to *Wang's* publication date of May 19, 2005.

With respect to 35 U.S.C § 102(b), the Applicant shall be entitled to a patent unless "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." *Wang* does not qualify as prior art under 102(b) because the Publication date of *Wang* is May 19, 2005. Thus *Wang's* publication date, of May 19, 2005, is less than one year prior to the filing date of the international application, May 25, 2005, and in fact is also less than one year prior to the date on which the national phase under 35 § U.S.C. 371 was entered, February 10, 2006.

Moreover, *Wang* is neither evidence of abandonment of the invention, nor is it a foreign patent. Thus, *Wang* is not prior art under 35 U.S.C § 102(c) or (d). Furthermore, *Wang* also does not raise any inventor ship issues. Thus, *Wang* is not prior art under sections (f) or (g) of 35 U.S.C. § 102.

Accordingly, Applicant assumes the Examiner referred to 35 U.S.C § 102(e) to qualify *Wang* as a prior art reference for the rejection under 35 U.S.C § 103(a), because the Examiner refers to *Wang* as having a foreign priority reference date of November 17, 2003. *Final Office Action* at p. 4. If that is the case, however, the MPEP provides that, "[f]or reference publications and patents of patent applications filed under 35 U.S.C. 111 (a), the prior art dates under 35 U.S.C. 102 (e) accorded to these references **are the earliest effective U.S. filing dates. No benefit of the filing date of the foreign application is given under 35 U.S.C. 102 (e) for prior**

art purposes (In re Hilmer , 149 USPQ 480 (CCPA 1966)). Thus, a publication and patent of a 35 U.S.C. 111 (a) application, which claims * > priority < under 35 U.S.C. 119 (a)-(d) to a prior foreign-filed application (or under 35 U.S.C. 365 (a) to an international application), would be accorded its U.S. filing date as its prior art date under 35 U.S.C. 102 (e)." *MPEP* at 706.02(f)(1) section III p. 700-32. (Emphasis added).

Wang's U.S. filing date is July 23, 2004, and claims priority under Section 119 to a Korean application filed November 17, 2003. *Wang*'s effective date as a reference under 35 U.S.C. 102(e) is July 23, 2004 as this date is the reference's earliest U.S. filing date. *See Id.* Thus, although *Wang's* foreign priority date is November 17, 2003, no benefit to this date is permitted under 35 U.S.C. 102(e) and 35 U.S.C. 103 for prior art reference purposes.

The present application claims the benefit of International Application No. PCT/KR2005/001539, filed May 25, 2005 (in English and designating the U.S.) which claims priority to Korean Application No. 2004-0041111, filed on June 5, 2004. Thus, the present application has an effective filing date of June 5, 2004. June 5, 2004, is prior to *Wang's* 35 U.S.C. 102(e) and 103 reference date, of July 23, 2004. Accordingly, for the foregoing reasons, *Wang* does not qualify as prior art under 35 U.S.C § 103(a), and to the extent the rejection of claims 1-3, 5, 7, and 9-15 rely on *Wang* under 35 U.S.C. § 103(a), it is improper and constitutes clear error.

The Office admits that neither *Boos* or *Day*, in combination or alone, discloses, "a lift coupled to an inner circumference of the drum main body to lift the laundry, wherein the cylindrical portion is provided with at least one penetration hole that is a predetermined distance apart from the first end and the second end of the drum main body, and wherein the lift is provided at a bottom surface with a positioning projection to be inserted into the penetration hole." *Non-Final Office Action* at p. 3. Thus, absent the teachings of *Wang,* the Office fails to set forth a prima facie case of unpatentability.

Therefore, for the reasons stated above and for the reasons stated in the Applicant's Response of June 15, 2009, Applicant respectfully requests the Office to withdraw the 35 U.S.C. § 103(a) rejection of claims 1-3, 5, 7, and 9-15.

2. **The Non Statutory Double Patenting Rejection Should be Withdrawn**

In the Non-Final and Final Office Actions, the Examiner rejected claims 1-3, 5, 7, and 9-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 7,395,612 to Jeong *et al.* (hereinafter "*Jeong '612*"), in view of *Boos*. *Non-Final Office Action* at p. 4 & *Final Office Action* at p. 3-5. This rejection is also improper for the following reasons.

It is noted that "[t]he **examiner bears the initial burden** of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the **applicant is under no obligation to submit evidence of nonobviousness**." *MPEP* at 2142. (Emphasis added). Under section 804(II)(b)(1) col. 2 of the MPEP, it calls for, "*>the<analysis employed in an obviousness-type double patenting rejection [to] parallel[s] the guidelines for analysis of a 35 U.S.C. 103 obviousness determination...Any obviousness-type double patenting rejection **should make clear**: (A) **The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application**; **and** (B) **The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue >is anticipated by, or< would have been an obvious variation of >,< the invention defined in a claim in the patent**." *MPEP* at 804(II)(b)(1) col. 2. (Emphasis added).

The Final Office Action does not follow this approach. Rather, The Examiner fails to provide the proper analysis discussed in MPEP sections 804 and 2142, and thus fails to meet the initial burden placed on the Examiner as well as the burden the Examiner bears in factually supporting any prima facie conclusion of obviousness. *MPEP* at 2142 & 804. In the Non-Final Office Action the Examiner merely states in conclusory fashion that "Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been an obvious to one skilled in the art to recite the claimed seam weld process of Boos...," with no explanation to back this conclusion. *Office Action* at p 4. Among other things, the Examiner fails to address how all of the features of independent claim 1 are rendered obvious by claims 1-33 of *Jeong '612*. Following the Non-Final Office Action, the Examiner maintained the double patenting rejection, but again failed to show how all of the features of independent claim 1 are rendered obvious by claims 1-33 of *Jeong '612*. *Final Office Action* at p. 5. Because the

Examiner did not take the required steps to address how all of the features of independent claim 1 are rendered obvious by claims 1-33 of *Jeong '612* in the Non-Final Office Action or Final Office Action, the Examiner has failed to meet the initial burden that is required to factually support a *prima facie* conclusion of obviousness, let alone clearly addressing the supporting facts to establish a prima facie conclusion of obviousness-type double patenting. *MPEP* at 2142 & *MPEP* at 804(II)(b)(1) col. 2. As a result, the Examiner's conclusions regarding obviousness type double patenting are improper.

Thus, as previously submitted, claims 1-3, 5, 7, and 9-15 are not obvious in view of claims 1-33 of *Jeong '612* because they are not coextensive in scope.

Accordingly, the Applicant respectfully requests that the obviousness-type double patenting rejection of claims 1-3, 5, 7, and 9-15 over claims 1-33 of the *Jeong '612* patent in view of *Boos* be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance.

CONCLUSION

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

Dated: December 18, 2009

Respectfully submitted,

By_____

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